

2. REMARKS / DISCUSSION OF ISSUES

Claims 1-3 are presently pending in the application. Claim 1 is independent. Claims are amended to delete certain common or required terminology under European practice. No new matter is added and the amendments are not made for statutory reasons.

Rejections under 35 U.S.C. § 102

Claims 1-3 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Taniguchi, et al.* (US Patent 6,568,083). For at least the reasons set forth herein, Applicants respectfully submit that the rejection is improper and should be withdrawn.

At the outset Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, a proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

i. Claim 2

The rejection of claim 2 under this section of the Code is improper because, as the Examiner concedes in the rejection of this claim under 35 U.S.C. § 103(a), at least one

feature of the claim is not disclosed in the applied art to *Taniguchi, et al.* Withdrawal of this rejection is solicited.

ii. Claim 1

Claim 1 is drawn to a shaving apparatus with a housing, and features:

*“...at least **one short-hair cutting device** projecting out of the housing through the passage and comprising a short-hair cutting tool...and with **at least one long-hair cutting device** projecting out of the housing through the passage and comprising a long-hair cutting tool ...and with a carrying device which carries both the short-hair cutting device and the long-hair cutting device and is provided for combined adjustment of the short-hair cutting device and the long-hair cutting device and being movable parallel to an adjustment direction between a first operating position and a second operating position such that both the short-hair cutting device and the long-hair cutting device , with the carrying device located in its second operating position, project farther out of housing than when the carrying device is located in its first operating position...”*

a. The Office Action fails to comply with MPEP § 706

MPEP § 706 states, inter alia:

“The goal of examination is to **clearly articulate any rejection** early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. The examiner then reviews all the evidence, including arguments and evidence responsive to any rejection, before issuing the next Office action.” (Emphasis provided.)

For at least the reasons set forth herein, Applicants respectfully submit that the Examiner has not clearly articulated the rejection. This renders the present rejection not compliant with the noted section of the MPEP.

The Office Action essentially reproduces the features of the claims and to some extent recites the features by reference character that are allegedly the same as certain claim features. However, the clear articulation ceases at page 3, where certain aspects of claim 1 are asserted to be found in the applied art but without any clear recitation to the

art. Rather, the Office Action directs Applicants to over four columns of disclosure in *Taniguchi, et al.* This places Applicants in the rather precarious position of having to speculate as to the relevance of the applied art to the claims under consideration. Respectfully, this is improper. Applicants thus submit that the rejection is improper and should be withdrawn. Moreover, if rejections are maintained, Applicants submit that these cannot properly be made final.

b. Taniguchi, et al. fails to disclose at least one feature of claim 1

The above notwithstanding, Applicants respectfully submit that a proper rejection for anticipation has not been made because the applied art does not disclose at least one feature of claim 1.

As will be appreciated from a review of claim 1, the short and long hair cutting devices both project farther out of the housing in a second operating position than a first operating position. The Examiner directs Applicants to the outer cutters 62 of the reference to *Taniguchi, et al.* for the featured short-hair cutting device; and to the long hair cutting unit 66 for the featured long-haired cutting device. Assuming arguendo that this is the case, the applied art nonetheless fails to disclose that both the short-hair cutting device and the long-hair cutting device, with the carrying device located in its second operating position, project farther out of housing than when the carrying device is located in its first operating position. Most notably, the reference fails to disclose the movement of the long hair cutting unit 66. At column 7, lines 5-25, the reference discloses:

The head cover 64 fixed to the cutter holder 63 is formed at its opposite longitudinal ends respectively with lugs 65 which fit slidably into corresponding vertical grooves 72 in opposite end walls of the head frame 70 so that the cutter holder 63 is vertically movable relative to the head frame 70. Thus, when the head frame 70 is mounted to the top of the housing 10, each cutter holder 63 can be depressed against the bias spring 44, i.e., be floatingly supported to the head frame 70 by use of the bias spring 44. The cutter holders 63 each carrying the outer cutter 62 are provided for short hair shaving, while a long hair shaving cutter unit 66 is also supported to the head frame 70 between the cutter holders 63 in such a manner as to be capable of being depressed against another bias spring (not shown) held at the interface between the long hair cutter unit 66 and the head frame 70.

The head frame 70 thus supporting the outer cutters 62 is mounted on top of the housing 10 and is connected to a height adjust mechanism so as to be vertically movable relative to the housing 10 between a high position of FIG. 1 and a low position. As shown in FIG. 4A, the height adjust mechanism comprises a slider 80, a rigid guide 90, and a handle or dial 100 all supported on the upper shell 14 at the upper end of the housing 10.

Applicants respectfully submit that the reference discloses the connection of the outer cutters 62 to the height adjustment mechanism, but does not disclose that both the short-hair cutting device and the long-hair cutting device, with the carrying device located in its second operating position, project farther out of housing than when the carrying device is located in its first operating position. As such, the applied art fails to disclose at least one feature of claim 1. Therefore a prima facie case of anticipation of claim 1 cannot be made based on *Taniguchi, et al.*, and claim 1 is patentable over the applied art. Moreover, claims 2-3 depend from claim 1, and are therefore patentable for at least the reasons discussed above and in view of their additional recitations of patentable subject matter.

Rejections under 35 U.S.C. § 103

Claim 2 is rejected under 35 U.S.C. § 103(a). While in no way conceding the propriety of this rejection because claim 2 depends from claim 1, it too is patentable for at least the reasons discussed above.

Conclusion

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
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